

REMARKS

Claims 1-16 are pending. Non-elected claims 1-15 have been withdrawn and claim 16 is under consideration.

Election/Restriction

The Examiner has acknowledged the Applicant's election of Group II, claim 16 drawn to a composition in the reply filed December 19, 2005. Although claims 1-16 are pending in this application, non-elected claims 1-15 have been withdrawn from consideration.

Claim Rejections Under 35 USC §102

The PTO rejects claim 16 under 35 U.S.C. §102(b) for alleged lack of novelty. In particular, the PTO asserts that the subject matter of claim 16 is anticipated by an experiment described by Rath et al. (*J. Med. Microbiol.*, January 2001, 50:108-109) in light of a PCR method disclosed by Greisen et al. (*J. Clin. Microbiol.*, 1994, 32:335-351).

Applicant respectfully traverses this ground for rejection. The present invention is directed to a composition suitable for use in nucleic acid amplification comprising water, gellan at a concentration above 0.005 wt% based on the weight of water, a DNA polymerase, dNTPs, and a target nucleic acid. Applicant submits that the PTO has failed to establish a *prima facie* case of anticipation under 35 U.S.C. §102.

As a first matter, Applicant submits that the PTO improperly combines references in asserting the novelty rejection under 35 U.S.C. §102. Multiple references should not be combined for a rejection under §102 unless the extra reference is cited A) to prove the primary reference contains an "enabled disclosure," B) to explain the meaning of a term used in the primary reference, or C) to show that a characteristic not disclosed in the primary reference is inherent. See M.P.E.P. § 2131.01. Applicant submits that none of the conditions set forth in M.P.E.P. §2131.01 is present in the instant application, nor does the PTO point to any of these conditions as having been satisfied. Additionally, and for reasons given herein, the publications cited by the PTO fail to teach or suggest the presently claimed subject matter.

With regard to Rath et al., Applicant respectfully submits that the PTO fails to recognize that as described therein, in the steps of DNA extraction using phenol-chloroform and DNA precipitation using isopropanol, gellan is separated from the DNA. Accordingly, the presently claimed composition is nowhere disclosed by Rath et al.

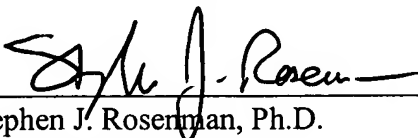
More specifically, Rath et al. begin with a composition that comprises water, gellan and DNA. The DNA is then extracted from this composition with phenol-chloroform and precipitated with isopropanol, thereby separating the DNA from the gellan, and the PTO provides neither evidence nor reasoning to demonstrate otherwise. When the isolated DNA of Rath et al. is subsequently contacted with a PCR reaction mixture containing a DNA polymerase and dNTP, the reaction mixture does not contain gellan at a concentration above 0.005 wt% as recited in the instant claim. Hence, the PTO has failed to establish a *prima facie* case of anticipation, and the deficiencies of Rath et al. are not remedied by Greisen et al. Greisen et al. merely disclose PCR primers and methodologies, but this reference fails, alone or in combination with Rath et al., to teach or in any way suggest the subject matter of claim 16.

Applicant therefore submits that the rejection under 35 U.S.C. §102 has been overcome, and its withdrawal is respectfully requested.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC



Stephen J. Rosenman, Ph.D.
Registration No. 43,058

SJR:rp

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031
794104_2.DOC